

REMARKS/ARGUMENTS

The Office Action dated August 3, 2009 has been carefully considered. It is believed that the following comments represent a complete response to the Examiner's comments and place the present application in condition for allowance. Reconsideration is respectfully requested.

35 USC §103

The Examiner has rejected claims 1, 3, 5-13, 16-19 and 32-53 under 35 USC §103 as being obvious in light of Cobley (U.S. Patent No. 6,528,687) in view of Abdur-Rashid (WO 03/097571).

According to the Examiner, Cobley teaches a process of making an amine from an imine in the presence of a base, a ruthenium complex of a chiral diphosphine and a chiral diamine. The Examiner contends that Cobley teaches a process wherein the substituent (R^3 in formula 10 or 11) on the nitrogen is a non-interfering organic group, and the Examiner has interpreted this group to be hydrogen substituted C-C double bond or C-C triple bond. The Examiner admits that while the variable R^3 in Cobley is an alkylaryl group, the variable R^3 in the present application is an alkyl group. To remedy this deficiency in Cobley, the Examiner cites Abdur-Rashid for its teaching of the hydrogenation of dialkyl, alkylalkenyl or dialkenyl imines. Accordingly, the Examiner alleges that the presently claimed process of preparing an amine from an imine would have been obvious.

The Examiner also rejected the Applicant's argument that Abdur-Rashid is not a citable prior art reference, on the basis that the Applicant did not provide evidence that Abdur-Rashid and the present application were commonly owned on the *date of invention* of the present application. For the reasons that follow, the Applicant respectfully traverses the Examiner's objection.

The Applicant respectfully submits that the Examiner's obviousness objection is improper as Abdur-Rashid is not a citable prior art reference. As noted by the Examiner,

Section 715.01(b) of the Manual of Patent Examining Procedure (current web edition), states:

Where, however, a rejection is applied under 35 U.S.C. 102(f)/103 or 35 U.S.C. 102(g)/103, or, in an application filed on or after November 29, 1999, under 35 U.S.C. 102(e)/103 using the reference, a showing that the invention was commonly owned, or subject to an obligation of assignment to the same person, at the time the later invention was made would preclude such a rejection or be sufficient to overcome such a rejection. [emphasis added]

The Applicant submits that the present application and Abdur-Rashid were commonly owned at the time the present invention was made, and therefore, Abdur-Rashid is not citable prior art under 35 USC 102(e).

The Applicant respectfully submits that in their response dated April 2, 2009, they established that the date on which the ownership of the Abdur-Rashid application was transferred from Robert H. Morris to Kamaluddin Abdur-Rashid was May 8, 2003.

In support of the contention that the date on which the present invention was made is later than the date on which Abdur-Rashid was assigned, the Applicant has submitted a Declaration under 37 CFR §1.132 with this Response. The Applicant swears in the Declaration that the date on which the present invention was made is after May 8, 2003, the date on which Abdur-Rashid was assigned to the Applicant.

The Applicant respectfully submits that there are two components for establishing the date of an invention: i) conception, and ii) reduction to practice. As defined in *Mergenthaler v. Scudder*, 11 App. D.C. at 276, conception constitutes "the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice." [emphasis added]

The Applicant respectfully submits that the date the present invention was made is the first day on which the hydrogenation of an unactivated imine falling within the scope of formula I was successfully hydrogenated using the process of the present application. The Applicant respectfully submits that this day was after May 8, 2003.

Accordingly, the Applicant respectfully submits that Abdur-Rashid was commonly owned at the time the present invention was made and is not a proper citation against the present application.

In light of the above, the Applicant requests that the Examiner's rejection of claims 1, 3, 5-19 and 25-53 under 35 USC §103(a) as being obvious in light of Cobley be withdrawn.

The Commissioner is hereby authorized to charge any fee (including any claim fee) which may be required to our Deposit Account No. 02-2095.

In view of the foregoing comments and amendments, we respectfully submit that the application is in order for allowance and early indication of that effect is respectfully requested. Should the Examiner deem it beneficial to discuss the application in greater detail, he is invited to contact the undersigned by telephone at (416) 957-1665 at his convenience.

Respectfully submitted,

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